1   (D)   REMARKS, including DRAWING AMENDMENTS, if any

2   The sole issue is the rejection of all claims under 35 U.S.C. 102(b) as being anticipated by U.S.

3   Pat. No. 5,875,240 (Silverman).

4   The rules of law are clear. Statute 35 U.S.C. 101 requires issuance of a patent for,

5   "...any new and useful process, machine, manufacture, or composition of matter, or any

6   new and useful improvement thereof...."

7   A valid rejection on the ground of anticipation requires the disclosure in a single prior art

8   reference *of each and every element of the claim* under consideration. Soundscriber Corp. v.

9   U.S., 148 USPQ 298, 301 (1966); In re Donohue, 226 USPQ 619, 621 (Fed. Cir. 1985).

10   Emphasis added.

11   The Action in para 2-7, paraphrases applicants' claims and inserts citations to Silverman. While

12   applicants appreciate the Examiner's efforts, looking to the actual words and drawings of

13   Silverman himself in describing his invention, it is clear that Silverman's patent fails to meet the

14   legal requirements for several reasons.

15   Silverman is a,

16   "METHOD FOR CALLED PARTY IDENTIFICATION AND CALL RE-ROUTING" (title).

17   Forman et al. discuss such known manner caller-id techniques in the Background section of

18   their specification. Forman et al. includes "...call-processing means conveys said information

19   signals *to a caller* on a call into said input-output port *prior to putting the call through* to said

20   telecommunications device." Forman et al., Claim 1. This is clearly a system for as Forman et

21   al's title describes it, "REVERSE CALLER-IDENTIFICATION." In other words, providing specific

22   feedback to the caller, not related to Silverman's call-forwarding scheme.

1   Silverman's own description is consistent from beginning-to-end that he is solving the problem

2   of the "called individual ...[being]...distinguished from any other individual associated with a

3   common telephone number...", so that the "...call is re-routed based upon ...called party

4   identification...." (Abstract). In the Office's specifically relied upon language in Col. 12, ll. 17-54,

5   Silverman only describes "...an operational flow for an embodiment fo the present invention

6   which does not require storing preferred time/location or *forwarding* parameters..." In other

7   words, via Silverman in general, automatic call rerouting is made to a called party in accordance

8   with pre-established data regarding potential whereabouts of the called party. More specifically,

9   the Silverman patent, is fundamentally about (1) identifying who you are trying to call by

10   attaching a *called* party ID to the incoming call, and (2) specific handling procedures at the

11   receiving end for calls intended for that called party ID. These handling procedures can include

12   e.g., forwarding or the destination device ringing a special ring depending on personal called-

13   party ID information, or displaying called party information, or returns handling information to the

14   calling party device. Specifically, in the main the called device has associated with it a

15   database for storing information as to how to handle incoming calls for specific parties, with the

16   FIG. 4E description relied upon by the Office being an alternative embodiment.

17   The Forman et al. invention is different in nature, in that fundamentally it is not about identifying

18   to the called party who you are trying to reach (as is 5,875,240) but instead, it is about

19   communicating information *to the calling party* information about who is near the phone in

20   question. The difference is as follows. In Silverman's description, the core idea is that you are

21   calling a shared line and for each of the sharing parties on the shared line, the database stored

22   instructions as to whether to ring (with a special ringtone or with their name) or reroute. Instead,

23   in the Forman et al. invention, the core idea is that you are calling a destination such as a

24   conference room (i.e., not a device that is your shared line, but instead a semi-public destination

25   that you happen to be reachable by), and the destination dynamically relays to the caller

26   (subject to security constraints) who can be reached by that device. Silverman is about routing

27   and handling for a specific called party ID (giving it a best guess by calling the shared line), the

28   Forman claimed invention is about calling a shared location and finding out who is there or what

29   is going on.

1   Moreover, as evidence from Silverman's own description, the illustration in Fig. 3 makes it clear

2   that this information is relatively static (i.e., standing instructions), rather than real-time

3   determination e.g. by proximity devices as in Forman et al.

4   However, the prior art embodied by 5,875,240 really is a small, specific step towards a well-

5   known concept that has been discussed endlessly among those trained in the state of the art, of

6   having telephone services for calling a person (regardless of where they are) rather than a

7   number. To the contrary, Forman et al. takes a different tact that is not about trying to reach a

8   specific person, but rather it is about giving the caller real-time information about what is going

9   on at the called location.

10   Again, looking to Silverman's own words as in claim 1: "...said call information including a called

11   party identification information that (a) uniquely identifies an individual for whom said call is

12   destined and (b) includes one or more forwarding parameters indicating....."

13

14   Morover, regarding Forman et al. claims 1 and 2, there is found no disclosure in Silverman for:

15   "...information signals to a caller" (Forman et al. Claim 1), nor "...real-time information

16   representative of current proximity of individuals to each of said telecommunications

17   devices,...provides said real-time information signals back to the caller..." (Forman et al. Claim

18   2). In other words, Silverman has no disclosure nor claim for sensing means for providing real-

19   time information signals indicative of real-time activity proximate said call-processing means.

20   The Forman et al. invention as claimed is about detecting who is near or what is going on near

21   the called device, and relaying that back to the calling party. Silverman does not disclose

22   anything to do with real-time or with any sensing means or with activity. He simply links a

23   called-party ID to a phone call and decides what to do with the call based on database

24   information at the destination. This factor also distinguishes Forman et al's independent claim

25   12 by elements such as "...real time information storage for collecting and storing data

26   representative of current activity..." and "...transmitting said data to said first known location...."

27   Distinguishing elements of Forman et al's independent claim 13 include: "...obtaining real-time

28   information regarding the environment proximate said device; transmitting...; and based on

1   predetermined feedback...." Distinguishing elements of Forman et al's independent claim 23

2   include: "...monitoring...current activities within a known proximity...," and "...transmitting a signal

3   representative of said current activities...."

4   Moreover, regarding claims 2 and 3, the devices are all part of a standard telephone set-up, but

5   the key novelty is not in having a database (lots of people have databases) but in having real-

6   time information representative of current proximity of individuals stored and updated in that

7   database.   Specific information, "...a roster of persons in proximity..." is claimed in Forman et al.

8   Claim 3.

9   Regarding claims 4 and 15, the pictures referred to in Silverman patent are to confirm the called

10   party ID (and be illustrative of the called party), as opposed to a real-time image of the

11   surroundings of the destination device.

12   Regarding Forman et al. Claim 5, Silverman refers to audio commands as to how to handle the

13   call, not audio playback of current persons in proximity (i.e. letting you hear what is going on in

14   the room).

15   Regarding Forman et al. Claim 6, claimed specific information on "...on-going

16   activity...proximate to said telecommunications device" is nowhere to be found in Silverman.

17   Regarding Forman et al. Claims 7 and 17, verifying that you are allowed to see said information,

18   is (a) dependent on said information being novel (see above) and (b) seems to make sense

19   (i.e., provide a means to stop someone from poking into the room). This is not discussed in

20   Silverman in any way. This is a funny one: Our invention is the equivalent of a window into a

21   conference room (with a dependent claim a security mechanism to prevent unauthorized people

22   from peeking through the window). The fact that Silverman has a security mechanism that

23   includes authenticating who is calling as a dependent claim to an altogether different invention
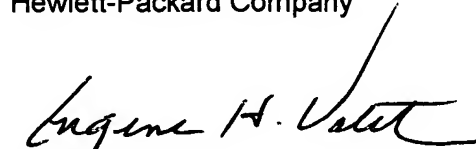
24   seems irrelevant.

1 Regarding Action para. 7 and the remainder of the Forman independent claims, the law is clear.

2 A dependent claim includes all the limitations of the claim from which it depends and, as such,

3 makes specific that which was general. 35 U.S.C. 112; 37 C.F.R. Sec. 1.75(c); Allen Group,

4 Inc. V. Nu-Star, Inc., 197 USPQ 849 (7th Cir. 1978); Ex parte Hansen, 99 USPQ 319 (Pat. Off.

5 Bd. App. 1953). Dependent claims are non-obvious if the independent claims from which they

6 depend are non-obvious. In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); see also Hartness

7 International, Inc. V. Simplimatic Engineering Co., 2 USPQ2d 1826, 1831 (Fed. Cir. (1987) to

8 the same effect re novelty). Thus, allowance of a base claim as patentable normally results in

9 allowance of a claim dependent upon that claim.

10 Based upon the foregoing, it is submitted that the application now presents claims which are

11 directed to novel, unobvious and distinct features of the present invention which are an

12 advancement to the state of the art. Reconsideration and early allowance of all claims is

13 respectfully requested. The right is expressly reserved to reassert any and all arguments,

14 including the raising of new arguments, should a Notice of Allowance not be forthcoming.

15 Questions or suggestions that will advance the case to allowance may be directed to the

16 undersigned by teleconference at the Examiner's convenience.

17 Date: _SEPT. 5, 2004_

18 Respectfully submitted,
Hewlett-Packard Company

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